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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,531	07/13/2006	Ray Davenport	205666-5040-00-US(455390)	4385

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DRINKER BIDDLE & REATH
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EXAMINER

GREEN, ANTHONY J

ART UNIT	PAPER NUMBER
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1731

NOTIFICATION DATE	DELIVERY MODE
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02/14/2011

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DBRIPDocket@dbr.com
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Office Action Summary	Application No. 10/552,531	Applicant(s) DAVENPORT ET AL.	
	Examiner Anthony J. Green	Art Unit 1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-7,9,10 and 12-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-7,9,10 and 12-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 13 January 2011 has been entered.

2. After entry of the amendment claims 1, 4-7, 9-10, and 12-14 are currently pending in the application.

3. Based on applicant's arguments and/or amendments the previous art rejections with respect to the following references are overcome and thereby withdrawn by the examiner: Luebke et al (US Patent No. 5,800,870 A) in view of Japanese Patent Specification No. JP60-215895 A; Japanese Patent Specification No. JP60-215895 A;

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 and 5-7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luebke et al (US Patent No. 5,800,870 A) in view of Nagler (US Patent No. 3,784,596 A).

Luebke et al teaches a method of coating paper by applying a paper coating composition comprising a binder and a pigment. The binder comprises a stable aqueous dispersion comprising a water insoluble component and a water soluble component such that the water insoluble component comprises coalescable polymer particles which have a T_g less than 55°C. and a majority of which have a particle size less than 1 micron; and the water soluble component comprises a water soluble polymer capable of inhibiting coalescence of said polymer particles, or a water soluble polymer and a component capable of inhibiting coalescence of said polymer particles; and wherein said water insoluble component comprises greater than 3% and less than 75% by weight of the binder solids and said water soluble component comprises greater than 25% and less than about 97% of said solids. According to column 5, lines 50+ the pigments useful include clay, calcium carbonate, plus others known in the art. Column 6, lines 4+, recite the ranges of the amounts of the components. Column 5, lines 60-64 and column 6, lines 45+ teaches that starches and polymer latex emulsions may also be used as the binder.

Nagler teaches a paper coating composition comprising a polymeric binder, organic solvent, rheological modifier and a pigment. Column 6, lines 29+, teach the types of pigment which may be utilized which include inorganic pigments and organic pigments such as quinacridone red and phthalocyanine blue.

The instant claims are obvious over the combination of the references. While the primary reference does not recite the use of an organic pigment it does teach that that useful pigments include clay, calcium carbonate plus others known in the art and since the secondary reference teaches that both inorganic pigments such as clay, calcium carbonate and organic pigments may be utilized in paper coating compositions it would have been obvious based on the teachings of the secondary reference to utilize an organic pigment such as phthalocyanine or quinacridone (a type of acridine pigment) as the pigment in the composition of the primary reference without producing any unexpected results and thus arrive at the instant invention absent evidence showing otherwise. The claim would have been obvious because "a person of ordinary skill has good reason to pursue the known options with his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense." A predictable use of prior art elements according to their established functions to achieve a predictable result is *prima facie* obvious. See *KSR Int'l Inc. v. Teleflex Inc.*, 127 S Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007). Accordingly the use of any organic pigment in the primary reference would have been obvious to one of ordinary skill in the art absent evidence showing otherwise since the secondary reference appears to teach the equivalence of utilizing an inorganic pigment or an organic pigment in a coating composition. As for claim 5 it should be noted that no dye needs to be present in the composition as claim 1 recites that the amount of the dye may be equal to 0. As for claim 6 the primary reference teaches the addition of other materials that include some of those recited in this claim. As for claim 7 while the

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reference does not recite the claimed method the composition is the same and if the composition is physically the same, it must have the same properties. It is well settled that when a claimed composition appears to be substantially the same as a composition disclosed in the prior art, the burden is properly upon the applicant to prove by way of tangible evidence that the prior art composition does not necessarily possess characteristics attributed to the CLAIMED composition. In re Spada, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Circ. 1990); In re Fitzgerald, 619 F.2d 67, 205 USPQ 594 (CCPA 1980); In re Swinehart, 439 F.2d 2109, 169 USPQ 226 (CCPA 1971) and also Titanium Metals Corp. v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985). See also MPEP 2112.01 [R-3] I and II. As for claim 9 the references teach the use of the compositions to treat paper. Accordingly the instant claims are obvious over the reference absent evidence showing otherwise.

6. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rajaraman (US Patent No. 6,500,896 B1) for the reasons set forth in the previous office action and which are herein incorporated by reference.

Applicant argues that the instant claim is not rendered obvious by the reference as the reference fails to teach an organic colouring pigment as recited in claim 4.

To this argument the examiner respectfully disagrees as the reference teaches that Red Lake C which is an azo pigment and the instant claim clearly states that a monoazo pigment may be utilized. Accordingly the instant claim is obvious over the reference.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Matuki (US Patent Application Publication No. 2005/0250891 A1) for the reasons set forth in the previous office action and which are herein incorporated by reference.

Applicant argues that the instant claim is not obvious over the reference as the reference does not teach an organic colouring pigment as recited in claim 4.

To this argument the examiner respectfully disagrees. The reference teaches that organic pigments conventionally used may be utilized in the invention and it is the examiner's position one of ordinary skill in the art would expect any organic pigment to function in the invention absent a showing to the contrary. A predictable use of prior art elements according to their established functions to achieve a predictable result is *prima facie* obvious. See *KSR Int'l Inc. v. Teleflex Inc.*, 127 S Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007). Accordingly the instant claim is obvious over the reference.

8. Claims 4, 10, and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over PCT International Application No. WO 01/90263 A2).

The reference teaches a latex polymer based ink comprising (a) water, (b) a latex polymer, (c) pigment, (d) an acid neutralization agent and (e) a rewetting agent. The ink may further include a modified rosin polymer, non-ionic surfactant and adjuvants. According to paragraph 3 of page 5 the pigment may be any of those which are suitable for formulating offset lithographic printing inks such as CI Pigment Yellows, CI Pigment Oranges, CI Pigment Reds, CI Pigment Greens, CI Pigment Blues, CI Pigment Violets,

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CI Pigment Blacks and CI Pigment Whites. The latex polymer may be urethane latex polymers or acrylic latex polymers such as an acrylic latex polymer from S.C. Johnson Joncryl 537. The latex polymer is present in the amount of 10 to 50 wt %, the water is present in the amount of 25 to 60 wt % and the pigment is present in amounts of 10 to 25 wt %. The adjuvants may be waxes, antifoam agents, biocides, surfactants, corrosion inhibitors etc.

The instant claims are obvious over the reference as the reference provides the motivation to produce the instant composition. While the reference does not recite that the composition is for controlling the bleed fastness this is an intended use limitation. Ultimate utility does not make a composition patentable. That is, the future use of a composition adds little or no patentable weight to a composition claim when the composition is the same (In re Pearson 181 USPQ 641). Patentability does not depend upon intended use (Ex parte Wikdahl 10 USPQ2d 1546). As for the amounts of the components the reference teaches amounts that encompass or overlap the claimed amounts. One of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the compositional proportions taught by the reference overlap the instantly claimed proportions and therefore are considered to establish a prima facie case of obviousness. It would have been obvious to one of ordinary skill in the art to select any portion of the disclosed ranges including the instantly claimed ranges from the ranges disclosed in the prior art reference, particularly in view of the fact that;

“The normal desire of scientists or artisans to improve upon what is already generally known provides the

motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages”, In re Peterson 65 USPQ2d 1379 (CAFC 2003).

Also, In re Geisler 43 USPQ2d 1365 (Fed. Cir. 1997); In re Woodruff, 16 USPQ2d 1934 (CCPA 1976); In re Malagari, 182 USPQ 549, 553 (CCPA 1974) and MPEP 2144.05. As for the type of pigment the reference teaches the use of pigments that encompass the claimed amounts. With respect to claim 10 the reference teaches the formation of an ink that may be used as a newspaper printing ink (page 5) and accordingly since the reference teaches an ink that may be used as a newspaper printing ink the formation of a paper coating with the ink composition is obvious. With respect to claim 12 it should be noted that no dye needs to be present in the composition as claim 4 recites that the amount of the dye may be equal to 0. As for claim 13 the reference teaches the addition of other materials that include some of those recited in this claim. As for claim 14 while the reference does not recite the claimed method the composition is the same and if the composition is physically the same, it must have the same properties. It is well settled that when a claimed composition appears to be substantially the same as a composition disclosed in the prior art, the burden is properly upon the applicant to prove by way of tangible evidence that the prior art composition does not necessarily possess characteristics attributed to the CLAIMED composition. In re Spada, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Circ. 1990); In re Fitzgerald, 619 F.2d 67, 205 USPQ 594 (CCPA 1980); In re Swinehart, 439 F.2d 2109, 169 USPQ 226 (CCPA 1971) and also *Titanium Metals Corp. v. Banner*,

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778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985). See also MPEP 2112.01 [R-3] I and II.

Accordingly the instant claims are obvious over the reference.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony J. Green whose telephone number is (571)272-1367. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry A. Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Anthony J Green/
Primary Examiner
Art Unit 1731

ajg
February 8, 2011